REMARKS

Claims 1-7, 9, 11-24, 26-30, and 33-39 are pending in the application.

Claims 1-7, 9, 11-24, 26-30 and 33-39 stand rejected.

Claims 1, 2, 17, 18, 19, 23, 24, 26, 28, 29, 35, and 36 have been amended. Support for these amendments can be found throughout the originally filed application. For example, support can be found in FIG. 5, FIG. 6b and paragraphs [0062]-[0063] and [0068] of the specification.

Rejection of Claims under 35 U.S.C. §103

Claims 1-7, 9, 12-24, 26-30 and 33-39

Claims 1-7, 9, 12-24, 26-30 and 33-39 stand rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over Hack, et al., U.S. Publication No. 2003/0187675 ("Hack"), in view of SAP.com, 2002 ("SAP.com"), and in view of Stoneking, et al., U.S. Publication No. 2003/0050814 ("Stoneking"). *See* Office Action, pp. 2-16. Applicants respectfully traverse this rejection.

Independent claims 1, 17, 23, 26, 28, and 35 each recite limitations directed toward (1) estimating benefits that are to be gained by the organization when one or more business challenges, or best practices, are addressed or implemented, and (2) the claimed estimating comprising adjusting a metric. The Office Action relies upon SAP.com for a teaching of the first of these limitations and upon Stoneking for a teaching of the second. *See* Office Action, pp. 3-5 and 11-13. Applicants submit (1) that the cited sections of Stoneking fail to teach any kind of estimating (and thus fail to teach any kind of estimating comprising adjusting a metric), and (2) that there is no reasonable expectation that SAP.com's alleged estimating could be modified to

Application No.: 10/661,877

comprise adjusting a metric to produce a successful result (according to the teachings of

Stoneking or the teachings of any other reference).

In order to support its assertion that Stoneking teaches a kind of estimating that

comprising adjusting a metric, the Office Action argues that Stoneking

> discloses using [its] questionnaires as input into an inductive engine that uses an
> inductive algorithm to detect which questions drive toward specific outcomes,
> where the algorithm loops through multiple solutions using the data that has been
> collected, where the looping through multiple solutions is adjusting a metric.

See Office Action, pp. 4-5 and 12-13 (citing Stoneking, paragraphs 129-134). However, even if

Stoneking's looping involves adjusting a metric (a proposition Applicants do not concede), the

cited sections fail to provide any evidence that Stoneking's inductive algorithm involves, or

results in, any kind of estimating. The cited sections fail to mention "estimating," and a person

having ordinary skill in the art would recognize that the mere mention of an inductive algorithm

would not show, teach, or suggest estimation. Inductive algorithms do not necessarily involve, or

result in, estimation. Likewise, the cited sections fail to provide any showing, teaching, or

suggestion that the detection of Stoneking's questions involves any kind of estimation. Indeed,

employing estimation in the detection of questions from a questionnaire is nonsensical. The

questions are either detected or they are not. Thus, Applicants submit that the cited sections of

Stoneking fail to teach any kind of estimating. Therefore, Applicants submit that the cited

sections fail to teach any kind of estimating, and certainly none that comprises adjusting a

metric.

In addition, in order to support its assertion that it would have been obvious to estimate

benefits that are to be gained by the organization when one or more business challenges, or best

practices, are addressed or implemented, the Office Action proposes to modify Hack "to include

the estimation and value calculator as taught by SAP[.com]." *See* Office Action, p. 4. Thus, in

order for the modified version of Hack to include a kind of estimating that comprises adjusting a metric, it is SAP.com's value calculator that must be somehow modified to perform estimations that comprise adjusting a metric. However, there is no reasonable expectation that the teachings of Stoneking, or any other reference, could be successfully combined with SAP.com's value calculators. SAP.com fails to disclose any information concerning the inner-workings of its value calculators, thereby making it impossible to deduce the effect of any modifications to its value calculators, and so precluding the development of a reasonable expectation of success.

Moreover, SAP.com asserts that its value calculators use "metrics provided by Pittiglio Rabin Todd & McGrath" to perform its estimations. *See* SAP.com, p. 1, third and fourth full paragraphs (emphasis added). SAP.com fails to mention any other metrics as being employed in the calculation of its estimations. Thus, the only metrics mentioned in SAP.com are those provided to SAP.com's value calculators from an outside source. SAP.com provides no reason to suppose that SAP.com's value calculators could continue to operate successfully were these provided metrics to be adjusted. In fact, it is apparent that SAP.com's value calculators would malfunction or provide less-accurate data if the metrics provided were altered in any way. Thus, there can be no reasonable expectation that SAP.com's alleged estimating could somehow be modified to include adjusting a metric, according to the teachings of Stoneking or of any other reference, to produce a successful result.

Thus, for at least the above reasons, Applicants respectfully submit that the combination of Hack, SAP.com, and Stoneking fails to teach each of the limitations of the current claims and fails to provide the required prima-facie case of obviousness. For at least these reasons, Applicants respectfully request the reconsideration and withdrawal of the rejection against independent claims 1, 17, 23, 26, 28, and 35, and a notice of the allowance of the same. Since the

remaining rejected claims are respectively dependent upon these independent claims, and therefore, also recite the limitations discussed above, Applicants respectfully request the reconsideration and withdrawal of the rejection against the remaining rejected claims, and a notice of the allowance of the same, for at least the same reasons.

In addition, Applicants have amended the independent claims to more clearly recite these distinctions. Amended independent claims 1, 17, 23, 26, 28, and 35 now recite limitations directed toward (1) the claimed estimating comprising ranking a plurality of metrics based on one or more of a plurality of user-specified rankings, and (2) adjusting the plurality of metrics based on the ranking of the plurality of metrics. The combination of Hack, SAP.com, and Stoneking fails to teach each of the limitations of the amended claims, at least because

> (1) the Office Action acknowledges that Hack fails to disclose the claimed estimating (*see* Office Action, pp. 3, 5, 11, and 13),
>
> (2) SAP.com provides no information concerning the inner-workings of its value calculators, stating only that its calculators use metrics provided by Pittiglio Rabin Todd & McGrath, as noted above,
>
> (3) the cited sections of Stoneking fail to disclose estimating, as discussed above,
>
> (4) Applicants can find no teaching in any of the cited sections of any of the references of the ranking of a plurality of metrics (let alone a ranking of a plurality of metrics based on one or more of a plurality of user-specified rankings), and
>
> (5) Applicants can find no teaching in any of the cited sections of any of the references of the adjusting of a plurality of metrics based on a ranking of the plurality of metrics.

Thus, for at least this additional reason, Applicants respectfully request the reconsideration and withdrawal of the rejection against amended independent claims 1, 17, 23, 26, 28, and 35, and a notice of the allowance of the same. Since the remaining rejected claims are respectively dependent upon these independent claims, and therefore, also recite the amended limitations discussed above, Applicants respectfully request the reconsideration and withdrawal

Application No.: 10/661,877

of the rejection against the remaining rejected claims, and a notice of the allowance of the same, for at least the same reasons.
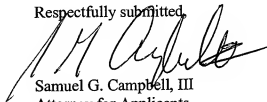
<u>Claim 11</u>

Claim 11 stands rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over Hack, in view of SAP.com, Stoneking, and Spangenberg, et al., U.S. Publication No. 2004/0260585 ("Spangenberg"). *See* Office Action, p. 16. Since claim 11 is dependent upon independent claim 11, and therefore, also recites the limitations discussed above, Applicants respectfully request the reconsideration and withdrawal of the rejection against claim 11, and a notice of the allowance of the same, for at least the same reasons given above.

CONCLUSION

In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5084.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicant hereby petitions for such extensions. Applicant also hereby authorizes that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. § 1.16 or § 1.17, be charged to deposit account 502306.

Respectfully submitted,

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Application No.: 10/661,877